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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT H. LORSCH

Appeal 2018-000204¹
Application 12/204,474
Technology Center 3600

Before MURRIEL E. CRAWFORD, NINA L. MEDLOCK, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL²

The Appellant³ appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 16–18 and 36. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

¹ We note previous appeal 2013-010061, for which a Decision was mailed March 22, 2016. We also note related appeals 2017-010566 (application 11/512,745) and 2017-010897 (application 11/690,996).

² Throughout this opinion, we refer to the Appellant's Appeal Brief ("Appeal Br.," filed July 10, 2017), Reply Brief ("Reply Br.," filed Oct. 9, 2017), and Specification ("Spec.," filed Sept. 4, 2008), and to the Examiner's Answer ("Ans.," mailed Aug. 11, 2017) and Final Office Action ("Final Act.," mailed Dec. 7, 2016).

³ According to the Appellant, the real party in interest is "MyMedicalRecords, Inc., a subsidiary of MMRGlobal, Inc. (MMRF)." Appeal Br. 6.

STATEMENT OF THE CASE

The Appellant's invention generally "relates to the provision of online medical records," and more specifically to "providing a means for consumers to request their medical records from health care providers, store the medical records, provide for private communications between the consumers and their health care providers, and allow consumers to selectively provide emergency access to their medical records." Spec. 1, ll. 12–16.

Claims 16 and 36 are the independent claims on appeal. Claim 16 (Appeal Br. 18–19 (Claims App.)) is exemplary of the subject matter on appeal and is reproduced below:

16. A method for providing a user with the ability to access and collect personal health records associated with the user, comprising:

providing a phone number to the user for fax and voice communications from a health care provider such that the fax and voice communications from the health care provider are stored and made available to the user through a single user account of a web site stored on a web server;

associating access information with the user account for the user to use to access the web site through use of a user id and first password;

providing the user with a document to provide to the health care provider exercising legal rights of the user for access to the health records, the document requesting the health care provider to send the health records to the phone number;

receiving a fax communication comprising the personal health record associated with the user for which the user has requested and given permission to the health care provider to send;

converting the fax communication into an image file format;

storing the personal health record associated with the user encoded in the image file format such that the personal health record associated with the user is accessible through the user account on the web server;

providing the user with access to the user account web site using the access information and providing on the web site an interface to the personal health records of the user for the user to access the health record;

providing the user with a means to organize health records into folders on the web site and to specify a subset of the personal health records for storage in an emergency folder, the subset of the personal health records stored in the emergency folder being accessible to the user through the user account by using the first password;

making available only the personal health records stored in the emergency folder through a separate element indicative of an emergency login into the user account on the web site using an emergency password; and

displaying through the web site an image of the user upon the emergency login into the web site.

THE REJECTION

Claims 16–18 and 36 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 2.

ANALYSIS

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for*

Molecular Pathology v. Myriad Genetics, Inc., 133 S. Ct. 2107, 2116 (2013)).

The Supreme Court in *Alice* reiterated the two-step framework, set forth previously in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 78–79 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are *directed to* one of those patent-ineligible concepts.” *Id.* (citing *Mayo*, 566 U.S. at 79) (emphasis added). If so, the second step is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether the additional elements “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea, and merely invoke generic processes and machinery, *i.e.*, “whether the focus of the claims is on [a] specific asserted improvement in computer capabilities . . . or, instead, on a process that

qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016).

Under the first step of the *Alice* analysis, the Examiner looks to the language of the independent claims and determines that the claims are directed to maintaining, providing access to, and collecting personal health records, i.e., organizing, storing, and transmitting data of health records, an abstract idea. *See* Final Act. 2; Ans. 3. We agree with and find supported the Examiner’s determination. The Appellant does not contest the Examiner’s determination of what the claims are directed to. *See* Appeal Br. 14. Rather, the Appellant focuses on the second step of the *Alice* analysis and contends that the Examiner’s rejection is in error because “when looked at as an ordered combination, [the claims] amount to significantly more than an abstract idea such as using categories to organize, store and transmit information as contended by the Examiner.” *Id.*; *see also* Reply Br. 14. We do not agree.

The Examiner determines that the claims limitations, alone or in combination, do not amount to significantly more than the abstract idea because they

amount to no more than a recitation of A) generic computer structure that serve to perform generic computer functions that serve to merely link the abstract idea to a particular technological environment (i.e. computers, network, internet, servers, processors)[;] . . . and B) functions that are well-understood, routine, and conventional activities previously known to the pertinent industry (i.e. receiving, providing, transmitting, generating).

Final Act. 3 (citing Spec. ¶¶ 29, 48). We agree with and find this supported.

The recited steps of method claims 16 and 36 of providing a phone number or address, associating data of access information, providing a document, and receiving a communication all relate to providing, organizing (associating), and receiving data (*cf.* Appeal Br. 14; Reply Br. 14–15), can all be performed manually, and are not recited to require a computer or other technology. The steps of method claims 16 and 36 of storing data relating to communications, receiving a fax communication, converting data, storing data of a health record accessible via a website, providing user access to a website using access data (i.e., logging in), providing a user interface, providing a means to organize data on the website, making available data of a subset of the record, and displaying image data are accomplished by generic servers, computer(s), and fax machine operating performing routine, well-understood and conventional functions of a generic computer or fax machine. There is no further specification of technology or indication in the Specification that any technologically novel or inventive hardware is required. *See Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1263 (Fed. Cir. 2016); *see also Enfish*, 822 F.3d. at 1336 (focusing on whether the claim is “an improvement to [the] computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity”).

None of the elements improves the technology of the servers, computer, or fax machine. *Cf.* Appeal Br. 14. To the contrary, the Specification describes and depicts generic fax and web servers, telephone, databases, and computer. *See* Spec. 13, l. 16–14, l. 13, 16, l. 20–18, l. 30, Figs. 1, 4. The computer implementation here is purely conventional and performs basic functions. *See Alice*, 134 S. Ct. at 2359–60; *see also Content*

Extraction & Transmission LLC v. Wells Fargo Bank Nat'l Assn., 776 F.3d 1343, 1347–49 (Fed Cir. 2014) (using scanner to convert paper document to store electronically was conventional, well-understood, and routine activity and function of scanning technology).

We disagree with the Appellant's contention that the claims are directed to patent-eligible subject matter because they use "effectively a special purpose server configured to provide the web site of Applicant's claimed invention." Appeal Br. 15; *see also* Reply Br. 16. The claims do not recite a server or computer configured to provide a web site, or any steps specifically performed by a server or computer. Further, the programming or purpose of the computer does not focus on a specific improvement in how the computer could carry out its basic functions of providing, storing, organizing, receiving, making accessible, and displaying data. *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016); *see also EON Corp. IP Holdings LLC v. AT & T Mobility LLC*, 785 F.3d 616, 623 (Fed. Cir. 2015) ("A microprocessor or general purpose computer lends sufficient structure only to basic functions of a microprocessor. All other computer-implemented functions require disclosure of an algorithm"); *and Alice*, 134 S. Ct. at 2357–60 (determining that applying an abstract idea, such as an algorithm, on a general purpose computer is not enough to transform a patent-ineligible abstract idea into a patent-eligible invention).

We are also not persuaded of Examiner error by the Appellant's argument that the claims are not directed to an abstract idea because they are not "routine or conventional activities previous [sic] known to the pertinent industry" because they were "found to be nonobvious in a March 22, 2106, decision by the Patent Trial and Appeal Board (PTAB)." Appeal Br. 15–16;

see also Reply Br. 16–17. First, the test under § 101 is not whether the activities are conventional activities known in the industry, but, as discussed above, whether the steps are conventional, routine, and well-understood functions of a generic computer. We have determined they are. Second, in the March 22, 2016 Decision for previous appeal 2013-0010061 (“Decision”), the Board did not find the claims nonobvious, but, rather, did not sustain the Examiner’s rejection of claims 16–18 and 36 because “the Examiner does not explain how the registration document of Segal requests the health care provider to send the records to the phone number, as claimed.” Decision 11. Third, an abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it. *See Mayo*, 566 U.S. at 91. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Myriad*, 133 S. Ct. at 2117. Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981); *see also Mayo*, 566 U.S. at 91 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”).

Thus, we are not persuaded of Examiner error in rejecting claims 16-18 and 36 under 35 U.S.C. § 101, and we sustain the Examiner’s rejection.

DECISION

The Examiner's rejection of claims 16–18 and 36 under 35 U.S.C. § 101 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED